

REMARKS

The undersigned attorney would like to thank the Examiner for taking the time to conduct a telephone interview concerning this patent application and the pending claims. The issues discussed in that telephone interview are fully provided in the Remarks that follow.

Rejections under 35 U.S.C. § 102(b)

Claims 10, 12, 14, 17, 19, 21 and 23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Statutory Invention Record H1,870 of Mizata, *et al.*

Claim 10 is an independent claim for a cross-linked expanded elastomeric safety support. The elements of the claim include, *inter alia*, “said support comprising a reinforcing filler . . . and a blowing agent in an amount greater than 2 phr. (Claim 10).

MPEP § 2131 provides:

“A claim is anticipated **only if each and every element** as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “**The identical invention must be shown in as complete detail as is contained in the . . . claim.**” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990) [Emphasis added].

Furthermore, the Federal Circuit held in *Paperless Accounting, Inc. v. Bay Area Rapid Transit Systems*, 804 F.2d 659 (Fed. Cir. 1986): “[A] §102(b) reference must sufficiently describe the claimed invention to have placed the public in possession of it.” *Id.* at 665.

Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented because the cited prior art reference **fails to disclose each and every element as set forth in the pending independent claim 10**. Specifically, the cited prior art references fail to disclose a blown product having a blowing agent in an amount greater than 2 phr.

As discussed in the telephone interview referred to above, a rejection based on anticipation must disclose each and every element as set forth in the claim. Indeed, as the MPEP and the Federal Circuit instruct, “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Id.*

The Examiner states “Mizata discloses a **cross-linkable**, **expandable** filling material comprising . . . 4-10 phr chemical blowing agent (tables 1 and 2).” (*See*, Final Office Action, p. 2, ¶ 5). The conclusion of the Examiner is: “Accordingly, Mizata anticipates the claimed subject matter. *Id.*”

Applicant respectfully asserts that it is immaterial as to whether or not Mizata discloses that which the Examiner asserts is disclosed by Mizata. What is material is that **Applicant does not claim that which the Examiner points out as being disclosed by Mizata.**

Specifically, Applicant claims “A **cross-linked expanded** elastomeric safety support.” (Claim 10). The Applicant claims “said [cross-linked expanded] safety support comprising . . . a blowing agent in an amount greater than 2 phr.” (Claim 10) [] material added.

While the Examiner asserts that Mizata discloses a cross-linkable, expandable filling material, such is not what Applicant claims. Applicant claims a support that is **already** cross-linked and **already** expanded.

Indeed, Table 1 of Mizata merely discloses “a representative formulation *for a composition for producing* the filler material is shown in Table 1.” (Mizata, col. 5, lines 7-8). [Emphasis added]. Therefore, while the material *that is to be foamed* has a blowing agent as disclosed by Mizata in Table 1, Mizata does not disclose an **expanded** blank still having a blowing agent **after being expanded**, which is what is claimed by Applicant in claim 10.

Since all claim elements **must be disclosed** by the single cited prior art reference to establish a *prima facie* case of anticipation, Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented for the reasons presented above. More specifically, because Mizata does not disclose an **expanded** blank comprising a blowing agent in an amount greater than 2 phr, and because the Examiner cites Mizata for merely disclosing an **expandable** and cross-linkable filling material, not a blank, Applicant asserts that a *prima facie* case of anticipation has not been presented. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 10 as well as dependent claims 12, 14, 17, 19, 21 and 23 depending therefrom.

Claim 7 and claims 24-27 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,567,742 of Park. Applicant claims a cross-linkable expandable blank

comprising, *inter alia*, a blowing agent and water, the water in an amount of from 3 to 6 phr.” (Claim 7).

Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented because Park fails to **disclose each and every element as set forth in the claims** of the Applicant. Specifically, Park fails to disclose a blank comprising water.

Applicant respectfully asserts that the claimed invention is not for a **composition**. Applicant does not claim a composition. Applicant claims a **blank, which is an apparatus**, comprising a blowing agent and water, the water in an amount of from 3 to 6 phr.

The Examiner states that because Park discloses a particular composition, then Applicant’s claim is anticipated. However, as noted above, Applicant does **not claim** a composition but claims an **apparatus**, namely a **blank**.

The Examiner states, citing *Ex parte Masham*, that although Park does not disclose a resin composition useful as an elastomeric safety support, it has been held that a recitation with respect to how manner in which a claimed blank from a prior art resin composition is intended to be employed does not differentiate the claimed blank from a prior art resin composition satisfying the claimed structural limitations. (Final Office Action, p. 10, ¶ 11).

Applicant respectfully disagrees with the Examiner’s analysis and citation of *Masham*. Indeed, from the MPEP, § 2114, *Masham* is cited as supporting the statement that the manner of **operating a device** does not differentiate **apparatus** claims from the prior art. The MPEP cites *Masham* for teaching:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). [Emphasis in original].

MPEP, § 2114.

Masham therefore teaches that when a claimed **apparatus** is compared to a prior art **apparatus**, the purpose for the **use** of the claimed **apparatus** is not relevant to the patentability over the prior art apparatus if the **prior art apparatus** teaches all the structural limitations of the **claimed apparatus**. For example, if a prior art apparatus is a mousetrap and the claimed

apparatus teaches an apparatus for catching bugs that has exactly the same structure as the prior art mousetrap, then the fact that the claimed apparatus is for catching bugs and not mice does not make it patentable over the prior art mousetrap.

Such is not the case at bar. Applicant claims an **apparatus** and Parks, as stated by the Examiner, discloses a **composition, said composition being a gel**, the **unformed** composition being what is used as an anticipation rejection by the Examiner over a claim for an **apparatus**.

Parks does disclose an **apparatus**. However, the apparatus disclosed by Parks does not anticipate Applicant's claimed blank because the apparatus disclosed by Parks is neither a **blank** nor does it contain a blowing agent and water in an amount of from 3-6 phr. That portion of Parks that discloses an **apparatus** states:

After incorporation of the blowing agent, the foamable gel [composition] is typically cooled to a lower temperature to optimize physical characteristics of the foam product [apparatus]. The **gel** is then extruded through a die of desired shape to a zone of lower pressure to **form the foam product** [apparatus].

Park, col. 4, lines 60-64, [] material added. .

Here, the foamable gel is the **composition** cited by the Examiner. But Parks states that this foamable gel **composition** is then extruded through a die of desired shape to a zone of lower pressure to form the foam **product**, or **apparatus**. The **apparatus** disclosed by Parks are those useful for cushion packaging. (Parks, col. 5, lines 42-45). There is no disclosure by Parks that the **apparatus** made from the **gel composition** comprises a blowing agent and water because Parks discloses that when an apparatus is formed from the gel, the gel is foamed in the process of making the apparatus. Thus the foaming thereby consumes the foaming agent and water.

Park does not disclose that the gel is useful as an apparatus **or that the gel can form an apparatus**. Park merely discloses a composition that is a gel that can be processed through an extruder where the foaming agent in the gel **foams to form a new composition** (foamed material) and the **foamed material** is used to make the disclosed apparatus (foamed packing material).

Because Parks fails to disclose a blank, much less any apparatus of any type comprising a blowing agent and water in an amount of from 3 to 6 phr, Applicant respectfully asserts that a *prima facie* case of anticipation has not been provided. Therefore, Applicant respectfully

requests reconsideration and withdrawal of the rejection of claim 7 as well as for dependent claims 24-27, which depend therefrom.

Rejections under 35 U.S.C § 103(a)

Claims 11, 13, 15, 18, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Statutory Invention Record H1,870 of Mizata, *et al.* **as applied to claim 10** above and in view of U.S. Patent No. 6,135,180 of Nohara. Note that the final office action stated “as applied to claim 7 above.” Applicant assumes that this is a typographical error and that the Examiner was referring to the analysis of the rejection of claim **10**, which appeared “above” in the final office action. The analysis for the rejection of claim 10 appeared in paragraph 5 of the final office action and this rejection of claims 11, 13, 15, 18, 20 and 22 appeared in paragraph 6 of the final office action.

Claim 11 is an independent claim for a cross-linked expanded elastomeric safety support. The elements (or limitations) of the claim include, *inter alia*, “said support comprising a reinforcing filler . . . and azobisformamide in an amount greater than 2 phr. (Claim 11).

As stated in the MPEP, § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, **all the claim limitations** must be **taught or suggested** by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented because **the cited prior art references fail to teach or suggest all the claim limitations** of the pending independent claim 11.

For the reasons provided in the Remarks above concerning independent claim 10 above, Mizata does not disclose an expanded product having a blowing agent in an amount greater than 2 phr.

Likewise, Nohara does not disclose an expanded product having azobisformamide in an amount greater than 2 phr. Indeed, Nohara merely discloses that a tread may be formed of a material having azobisformamide **before** the foaming action. Nohara states: “Cells formed in the rubber composition **by foaming action of the foaming agent** at a vulcanizing step preferably have a whole cell fraction . . . “ (Nohara, col. 4, lines 38-40).

The Examiner states that it is known in the foam art that when a blowing agent is used for forming the voids, the foam material contains residues from the chemical blowing agent after expansion. (Final Office Action, p. 4, ¶ 7).

Applicant respectfully asserts that whether such knowledge is known or not in the foaming arts is immaterial because such is not what Applicant claims. Applicant claims that an amount of blowing agent, or in this case azobisformamide as the blowing agent, remains in an amount greater than 2 phr. This amount is greater than mere residues from the blowing agent. Indeed, it amounts to 2 % of the total amount of rubber in the composition and is a significant amount of material, not mere residue.

Applicant respectfully asserts that the Examiner has failed to provide **any** prior art reference that teaches, suggests or discloses that **any** amount of blowing agent remains in the expanded product and more specifically has failed to provide any prior art that teaches an amount of blowing agent remaining in an expanded product that is greater than 2 phr (claim 11) or greater than 5 phr (claim 13). A mere unsupported statement of the Examiner of the existence of residual blowing agent does not meet the standards of a *prima facie* case of anticipation.

Since all claim limitations **must be taught or suggested** by the cited prior art reference to establish a *prima facie* case of obviousness (See, MPEP § 2143.03 as cited above), Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented for the reasons presented above. More specifically, because the cited prior art references fail to disclose an expanded blank comprising a blowing agent (azobisformamide) in an amount greater than 2 phr, Applicant asserts that a *prima facie* case of obviousness has not been presented and therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 11 as well as dependent claims 13, 15, 18, 20 and 22 depending therefrom.

Claims 7-10, 14, 17, 21, 23-24 and 28 stand rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,787,607 of Sahnoune, *et al.*

Sahnoune claims priority to a provisional application, 60/182,852. It also claims priority to a PCT application, PCT/US01/04924, filed February 15, 2001.

The present application is a divisional application of U.S. Patent No. 6,673,848 filed April 25, 2001, which claims priority from the French Application 00/05346 filed April 25, 2000. (See Filing Receipt).

While the present application does not claim priority to a date prior to the filing of the provisional application of Sahnoune, it does claim priority to a date prior to the filing of the Sahnoune PCT application. Therefore, any disclosure of Sahnoune (U.S. Patent No. 6,787,607) that was not disclosed in the provisional application is not citable as prior art against the present application.

Applicant has examined the on-line copy of the Sahnoune provisional application and has determined that Tables 2 and 3 of Sahnoune are not disclosed in the Sahnoune provisional application.

Since those portions of Sahnoune that were cited by the Examiner are not prior art against the pending application, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 7-10, 14, 17, 21, 23-24 and 28.

Applicant respectfully asserts that all claims are now in condition for allowance and requests the timely issuance of the Notice of Allowance. If the Examiner believes that a telephone interview would expedite the examination of this pending patent application, the Examiner is invited to telephone the below signed attorney at the convenience of the Examiner.

Respectfully submitted,

MICHELIN NORTH/AMERICA, INC.

A handwritten signature in black ink, appearing to read 'F. Campigotto', is written over the printed name.

Frank J. Campigotto
Attorney for Applicant
Registration No. 48,130
864-422-4648